

## **REMARKS**

Applicants thank the Examiner for finding claims 11, 19 and 20 to be allowable if rewritten in independent form. Applicants respectfully request reconsideration of the above referenced patent application in view of the amendments and remarks set forth herein, and respectfully request that the Examiner withdraw all rejections. No claims have been amended. Claims 64-73 have been canceled without prejudice. No claims have been added. Thus, claims 1-22 are pending.

### **35 U.S.C. §102 Rejections**

#### **35 U.S.C. §102(b) Rejection over *Ellis***

The Office Action rejects claims 1-4, 7, 9, 12, 15, 18, 64-68 and 73 under §102(b) as being anticipated by Ellis, Jr., USPN 6,059,431 (*Ellis*). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, wherein the identical invention is shown in as complete detail as is contained in the claim. *See* M.P.E.P. §2131. For at least the following reasons, Applicant respectfully traverses the above rejection.

Claims 64-73 are canceled herein, rendering moot the above rejection as applied to claims 64-68 and 73. Rejected claims 1-4, 7, 9, 12, 15 and 18 include independent claim 1, which recites in a salient portion (emphasis added):

“...a means for positioning the light source within a rotating reference frame of a wheel, the positioning means to allow light from the light source directed outside the wheel such that an amount of light from the light source **incident upon and reflected from** a visible surface of the wheel is **greater than** an amount of light from the light source **directed away from** the visible surface of the wheel.”

Applicants submit that the above rejected claims are not anticipated by *Ellis* based at least on a failure of *Ellis* to expressly or inherently describe at least one limitation of claim 1. More particularly, the reference **fails** to describe an amount of light from a light source

incident upon and reflected from a visible surface of a wheel which is greater than an amount of light from the light source directed away from the visible surface of the wheel.

The Office Action alleges that FIG. 1 and 2 show a device 10 in a rotating reference frame of a wheel 12 which has a light source 38 whose light rays 70 are reflected within areas of the wheel and then outward. However, the Office Action **fails to** allege that *Ellis* discloses **any** quantitative description of how an amount of light from a light source incident upon and reflected from a visible surface of a wheel **compares to** an amount of light from the light source directed away from the visible surface of the wheel. Even assuming, *arguendo*, that all other claim limitations are anticipated, which Applicants do not agree, the reference is simply **silent** as to how any amount of reflected light rays might compare to any amount of light rays directed away from wheel 12. Therefore, *Ellis* fails to expressly or inherently describe Applicants' identical invention in as complete detail as is contained in the claim, as required by M.P.E.P. §2131.

The illumination device 10 in *Ellis* generates light from a lamp 38, which is projected through opening 36 by a reflector 40. Col. 3, line 38-43 of *Ellis* states (emphasis added):

"In operation, illumination device 10 is loaded with batteries 32 and 50 and fastened to axle 18 of wheel 12 by mounting means 58. Means 68 forming the circuit is activated and **permits the projection of light**, indicated by multiplicity of ray lines 70, **outwardly through opening 36** of channel 34."

However, *Ellis* fails to describe whether or how light projected outwardly through opening 36 might be directed such that an amount of the light which is incident upon and reflected from wheel 12 is **greater** than an amount which is directed away from the wheel 12.

The combination of a lamp 38 and reflector 40 in FIGS. 1 and 2 causes illumination device 10 to act as a flashlight. More particularly, the lamp 38 and reflector 40 combination of *Ellis* cause illumination device 10 to project light outwardly in **all** directions from opening 36 – i.e. as a 3-dimensional cone of light. *Ellis* happens to

discuss only ray lines 70, which reflect from wheel 12 (from col. 3, line 43-46, emphasis added):

“Such ray lines, further depicted in FIG. 1, indicate that light is reflected off tire rim 72 in various directions in the plane of wheel 12, as well as outwardly therefrom.”

Nevertheless, although FIG. 1 of *Ellis* shows a wide angle of ray lines 70 projected **along** a length of the rim of wheel 12, the combination of lamp 38 and reflector 40 would **also** cause a wide angle of light to be projected **away** from the rim of wheel 12. In other words, absent any additional disclosure in *Ellis*, the majority of the resulting 3-dimensional cone of light emitted from opening 36 would not be incident upon the wheel 12.

Such a projection of light predominantly away from the rim of wheel 12 serves an express purpose of *Ellis* to illuminate **users or operators** of motorcycles, bicycles, scooters, and the like. *Ellis* specifically states in col. 1, line 65 to col. 2, line 2 (emphasis added):

“Another object of the present invention is to provide an illumination device mounted to the wheel of a vehicle which provides illumination such that the **operator of the vehicle is easily seen** in nighttime conditions.”

Furthermore, col. 3, line 46-50 of *Ellis* states (emphasis added):

“The net effect is that **the user of the vehicle** associated with wheel 12 is **easily seen at night through the rotation** of wheel 12 **and the reflection** of the light rays 70 from illumination device 10 along rim 72 and outwardly therefrom.”

Applicants submit that it is light which is directed **away** from wheel 12— e.g. either away from or between spokes 16 – that illuminates an **operator** of the vehicle as wheel 12 spins. This light would be directly visible both by the operator of the vehicle and by an observer seeing the vehicle either approach or depart. Accordingly, *Ellis* achieves one of its express objectives by directing light **away** from wheel 12. By contrast, Applicants’ invention minimizes that light from a light source which is directly visible by an observer (see, e.g., paragraphs [0038] and [0050]).

For at least the foregoing reasons, *Ellis* fails to anticipate claim 1 in its current form. In depending directly or indirectly from claim 1, each of dependent claims 2-4, 7, 9, 12, 15 and 18 incorporates at least one limitation not taught by the reference. Therefore, Applicants request that the above 35 U.S.C. §102(b) rejection of claims 1-4, 7, 9, 12, 15 and 18 based on *Ellis* be withdrawn.

### **35 U.S.C. §103(a) Rejections**

#### **35 U.S.C. §103(a) Rejection over *Ellis***

The Office Action rejects claims 5, 6, 8, 13, 14, 16 and 17 under 35 U.S.C. §103(a) as being obvious in light of *Ellis*. For at least the following reasons, Applicant respectfully traverses these rejections.

As discussed above, *Ellis* fails to disclose at least one limitation of currently amended independent claim 1. More particularly, *Ellis* fails to disclose an amount of light from a light source incident upon and reflected from a visible surface of a wheel which is greater than an amount of light from the light source directed away from the visible surface of the wheel. The Office Action does not offer a further basis for *Ellis* teaching or suggesting this missing limitation. Applicants submit that *Ellis* **fails** to teach or suggest the above limitation. If an independent claim— e.g. claim 1— is non-obvious under 35 U.S.C. §103, then any claims depending therefrom— e.g. claims 5, 6, 8, 13, 14, 16 and 17— are also non-obvious. See M.P.E.P. §2143.03. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §103(a) rejection of claims 5, 6, 8, 13, 14, 16 and 17 based on *Ellis* be withdrawn.

#### **35 U.S.C. §103(a) Rejection over *Ellis* and *Hamilton***

The Office Action rejects claims 10 under 35 U.S.C. §103(a) as being obvious in view of *Ellis* and *Hamilton*, USPN 1,740,588 (*Hamilton*). *Hamilton* is alleged to disclose, *inter alia*, a lighting device including a reflector 6 and a conical shielding element 12. For at least the following reasons, Applicants traverse the above rejection.

As discussed above, *Ellis* fails to disclose at least one limitation of currently amended independent claim 1. More particularly, *Ellis* fails to disclose an amount of light from a light source incident upon and reflected from a visible surface of a wheel which is greater than an amount of light from the light source directed away from the visible surface of the wheel. The Office Action does not offer *Hamilton* as teaching or suggesting this missing limitation. Applicants submit that *Ellis* and *Hamilton* fail to teach or suggest the above limitation. Therefore, in depending from claim 1, claim 10 incorporates at least one limitation which is not taught or suggested by any combination of claim *Ellis* and *Hamilton*. For at least the foregoing reasons, Applicants request that the above 35 U.S.C. §103(a) rejection of claim 10 based on *Ellis* and *Hamilton* be withdrawn.

**35 U.S.C. §103(a) Rejection over *Ellis* and *Brown***

The Office Action rejects claims 21 and 22 under 35 U.S.C. §103(a) as being obvious in view of *Ellis* and *Brown*, USPN 6,016,101 (*Brown*). *Brown* is offered as disclosing, *inter alia*, the use of multiple lighting to illuminate a bicycle wheel. Applicants traverse the above rejection for at least the following reasons.

Claims 21 and 22 each depend from claim 1. As discussed above, *Ellis* fails to disclose at least one limitation of currently amended independent claim 1. More particularly, *Ellis* fails to disclose an amount of light from a light source incident upon and reflected from a visible surface of a wheel which is greater than an amount of light from the light source directed away from the visible surface of the wheel. The Office Action does not offer *Brown* as teaching or suggesting the above limitation. Applicants respectfully submit that no combination of the *Ellis* and *Brown* teaches or suggests the limitations which are not disclosed by *Ellis* on its own. For at least the foregoing reasons, Applicants request that the 35 U.S.C. §103(a) rejection of claims 21 and 22 based on *Ellis* and *Brown* be withdrawn.

**35 U.S.C. §103(a) Rejection over *Ellis* and *Hung***

The Office Action rejects claims 69 and 70-72 under 35 U.S.C. §103(a) as being obvious in view of *Ellis* and Hung, US Pub. No. 2003/0202356 (*Hung*). Claims 69 and 70-72 are canceled herein, rendering moot the above rejection.

CONCLUSION

For at least the foregoing reasons, Applicants submit that the objections and rejections have been overcome. Therefore, claims 1-22 are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present application. Please charge any shortages and credit any overcharges to our Deposit Account number 02-2666.

Respectfully submitted,  
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